

### **REMARKS**

Claims 1-20 are all the claims pending in the application.

#### **I. Preliminary Matter**

As a preliminary matter, Applicant respectfully requests that the Examiner return an initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on February 8, 2005. The Examiner indicated that the form PTO/SB/08 is attached to the Office Action. However, no form was attached and it is not available on USPTO website. Accordingly, Applicant respectfully requests the Examiner to return an initialed form PTO/SB/08 filed on February 8, 2005 with the next Office Communication.

#### **II. Summary of the Office Action**

The Examiner withdrew the objections to the specification but maintained the rejections of the claims. Specifically, claims 1, 3-7, 9-14, and 16-19 remain rejected under 35 U.S.C. § 102(a) and claims 2, 8, 15, and 20 are now rejected under 35 U.S.C. § 103(a).

#### **III. Claim Rejections Under 35 U.S.C. § 102(a)**

Claims 1, 3-7, 9-14, and 16-19 are rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Publication No. 2002/0104090 to Stettner (hereinafter “Stettner”). Applicant respectfully traverses these grounds of rejections and respectfully requests the Examiner to carefully reconsider at least in view of the following exemplary comments.

##### ***A. Legal Standard***

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus,

the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. MPEP § 2131.

***B. Exemplary Features of Claim 1***

Independent claim 1 *inter alia* and in some variation recites: a user search received via the digital broadcast channel of the television network and retrieving the advertising information from said data gateway based on the user search.

That is, in an exemplary, non-limiting embodiment of the present invention, the users send user searches over a digital broadcast channel of the television network, and the response is made by retrieving advertising information from the data gateway. Advertisers make information available but the information is provided to users in response to a user search for information. The advertisers put advertising information on file (via the internet), and users pull the information by way of a search (via the digital broadcast channel of the television network) *e.g.*, the user may request pizza delivery places in Alexandria, VA. In other words, unlike the conventional techniques, where the advertisers push the advertisement information to the selected users, for example, based on their personal information, in an exemplary embodiment, the user requests the needed advertising information via a pull based technique.

It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claim mentioned above.

***C. Disclosure of the Prior Art Reference***

Stettner discloses a system in which an information-available button or icon is made to be present during the viewing of an advertisement. The point in Stettner is to improve the results of

advertising by making it easy for the user to respond to the ad in front of them. Paragraph [0007] of Stettner describes how a TV ad for pizza, even when viewed by a hungry user wanting pizza, must necessarily be responded to by writing down the telephone number, calling the pizza restaurant, etc. To make responding easier, an “information-available” type button is made to be present. The user can use his TV to activate the button, thereby initiating a transaction (*see* button 404 in Fig. 4).

Specifically, Stettner discloses at 402, an interactive advertisement is presented to a potential customer via the systems of FIGS. 1-3. In the example shown in FIG. 4, the interactive advertisement 402 is a commercial for airline tickets. In Stettner, the interactive advertisement 402 may have an audio or visual (or both) indicator 404 to indicate the availability of enhanced content (e.g., product supplemental information), which the viewer can access using a viewer input device. In the example shown in FIG. 4, the indicator 404 is a "Buy" button that invites the viewer to buy airline tickets. The indicator 404 may be an "Info" button that requests the merchant to provide information about the tickets, there may be multiple indicators 404, or one or more indicators may be used for a combination of purposes (e.g., buying, requesting information, turning enhanced content on/off, activating a menu, etc.), according to various embodiments (¶¶ 49 and 50).

Stettner further discloses correlating a customer to an advertisement when the user clicks the indicator 404 (“Buy” button) (¶ 57). In Stettner, once the customer is correlated, the merchant 122 is notified by the advertising service (or other mechanism) at a block 512 to contact the customer. In an embodiment, the merchant 122 is notified implicitly by redirection of the customer’s browser or set top box 152 to the merchant’s 122 web site 124, for example. In Stettner, this redirection may be performed by a server in the distribution center 306 in one

embodiment, and results in a connection of the merchant 122 to the customer at a block 514.

This embodiment can be implemented via use of triggers that are embedded with the television transmission having the interactive advertisement 402. When the indicator 404 is clicked, the set top box 152 is redirected to the URL address of the merchant's web site 124, with the URL addresses capable of being obtained from the triggers or from other embedded information that is sent along with the interactive advertisement 402. In Stettner, once at the web site 124, the customer can communicate with the merchant 122 by filling out an electronic form or by providing other input (such as by clicking hyperlinks) to get the response fulfilled (§ 58).

***D. Examiner's Position***

The Examiner alleges that Stettner disclosure of the user pressing the indicator 404 "Buy" anticipates the user search set forth in claim 1 and in response to this command, advertising information is provided (*see* pages 2-3 of the Office Action).

***E. Applicant's Position***

Applicant respectfully submits that the advertising information is presented prior to the user pressing indicator 404 and without any user search. In addition, Applicant respectfully submits that a user pressing "Buy" indicator cannot and does not disclose a user search. These arguments are explained in greater detail below.

The focus of Stettner is to push the advertising information to a user who has not asked for it and then allow the user to buy the item being advertised. In other words, Stettner, just like conventional techniques, discloses a push based approach, where the advertising information is not provided/selected based on any user search. For example, as can be seen in Fig. 5 of Stettner, the user is forced to see an interactive advertisement (step 506). The user has not asked

for this advertisement; it is just an advertisement of the type common to broadcast media. That is, in Stettner, interactive advertisement is presented to the user without any user request (§ 49). In Stettner, the advertising is a push-based advertising and is not a pull based advertising that is provided in response to user search.

Furthermore, this advertising of the product is provided without any user request and prior to the user clicking on the “Buy” button, indicator 404 (alleged user search). That is, the point in Stettner is to improve the results of advertising by making it easy for the user to respond to the ad in front of them (e.g., § 7) by simply clicking a button to initiate a transaction (see button 404 in Fig. 4). In other words, the advertising is provided prior to any user request and clearly not in response to user search. In fact, the user can only respond to the advertising by activating an indicator 404.

In addition, clicking an “Info” button that provides additional information about the product or a “Buy” button to purchase the merchandise as disclosed in Stettner (§ 50) cannot and does not disclose a user search. No user search is performed as the corresponding merchandise is already selected (§ 51 of Stettner). That is, Stettner only discloses a user command to buy the merchandise being advertised on TV or to provide additional information about the merchandise being advertised and not a user search for advertising information e.g., a number of available merchandise meeting criteria specified in the user search.

***F. Concluding Remarks with Respect to Claim 1 and its dependent claims***

Accordingly, “an advertising information retriever configured to process a user search received via the digital broadcast channel of the television network, and to retrieve the advertising information from said data gateway based on the user search...,” as set forth in claim 1 is not disclosed by Stettner, which lack having a user search and retrieving the advertising

information based on the user search. For at least these exemplary reasons, claim 1 is patentably distinguishable from Stettner. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1 and its dependent claims 3-7 and 9.

**G. Claims 10-14 and 16-19**

Independent claim 10 recites *inter alia* “an interface unit configured to receive content information from an advertiser via an internet; a cable content generator configured to process the content information received by said advertiser interface and to generate advertising information adapted for transmission over the cable network.” That is, in an exemplary, non-limiting embodiment of the present invention, it is disclosed that the advertiser provides content information via internet and based on this information, the advertising is automatically generated and converted to a format acceptable for the cable network. Accordingly, the advertising information can easily be updated and modified by the advertiser.

In response to Applicant’s arguments that Stettner is silent with respect to how the advertising contents are created/generated, the Examiner simply refers to ¶¶ 42-48 of Stettner (*see* page 3 of the Office Action). These noted paragraphs of Stettner, however, only disclose various distribution channels *e.g.*, using internet 302 to distribute multimedia content, caches, and a server to guide user to the merchant’s website. Nowhere in the passages noted by the Examiner does Stettner disclose how the advertising content is generated.

In other words, Stettner only discloses the user interacting with the merchant via internet and is not directed to how the advertising contents are generated. Stettner does not disclose or suggest an interface unit configured to receive content information from an advertiser via an internet and a cable content generator configured to process the content information received by said advertiser interface and to generate advertising information adapted for transmission over

the cable network. That is, in Stettner, there is no disclosure or even remote suggestion of any creation of advertising information *e.g.*, converting of Internet content to a television format. In short, Stettner is not related to *how* the advertisements are generated or provided.

In view of the foregoing points, Applicant respectfully submits that the subject matter of claim 10 patentably distinguishes from Stettner. Claims 11-14 are patentable at least by virtue of their dependency on claim 10.

In addition, dependent claim 12 recites: “wherein the content information includes at least one of a geographic parameter and a temporal parameter, such that the cable network transmits the advertising information corresponding to the content information only within, respectively, a geographical area and a time period.” That is, claim 10, on which claim 12 depends, recites “an interface unit configured to receive content information from an advertiser via an internet.” This content information received from the advertiser includes geographic parameter and temporal parameter. In other words, the advertiser indicates when and where the information should be presented.

The Examiner alleges that customer’s location and that the indicator 404 is present during the advertising as allegedly disclosed in Stettner discloses the geographic and temporal parameters as set forth in claim 12 (*see* pages 7-8 of the Office Action). Applicant respectfully notes that the Examiner’s position is inconsistent with the position taken in claim 10. With respect to claim 10, the Examiner alleges that the information provided after the user presses indicator 404 is the alleged advertising information. Accordingly, the temporal parameter cannot be related to the indicator 404 but needs to be related to the information displayed after the user selects the indicator 404. Furthermore, Applicant respectfully notes that there is no disclosure or even remote suggestion in Stettner that this information is provided by the advertiser via internet.

In short, Stettner does not disclose or remotely suggest the advertiser specifying when and where to present the information to the customer along with the advertising information.

For at least these additional exemplary reasons, claim 12 is patentably distinguishable from Stettner.

Claim 16 recites features similar to the features argued above with respect to claims 1 and 10. Accordingly, claim 16 is patentably distinguishable from Stettner for at least analogous exemplary reasons. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 16 and its dependent claims 17-19.

IV. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 2 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stettner in view of a newly found reference, U.S. Publication 2008/0196053 to Thomas et al. (hereinafter “Thomas”) and claims 8 and 15 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Stettner in view of U.S. Patent 5,948,061 to Merriman et al. (hereinafter Merriman). Applicant respectfully traverses these grounds of rejections at least in view of the following exemplary comments.

Claims 2, 8, 15, and 20 depend on claim 1 or 10. Applicant has already demonstrated that the disclosure of Stettner does not meet all the requirements of independent claims 1 and 10. Stettner is relied upon only for its alleged disclosure of designating category and satellite transmission and Merriman is relied upon only for its disclosure of a report (*see* pages 11-13 of the Office Action) and as such fail to cure the deficient disclosure of Stettner. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1 and 10. Since claims 2, 8, 15, and 20 depend on claim 1 or 10, they are patentable at least by virtue of their dependency.



In addition, dependent claim 2 *inter alia* recites: “the user search comprises the user designating a category of advertising, based on the designated category, the advertising information retriever searches advertising information listings stored in the data gateway and selects the advertising listings that match the designated category and other criteria, said other criteria comprises at least a geographical location of the user.” The Examiner acknowledges that Stettner does not disclose or suggest the above-quoted unique features of claim 2. The Examiner, however, alleges that Thomas cures these deficiencies (*see* pages 11-12). Applicant respectfully disagrees.

Thomas is focused on monitoring usage of interactive television program guide. Thomas further discloses that real-time ratings information (e.g., real-time ratings of the popularity of certain television programs, video games, or other applications) may be provided to users in real time (*see* Abstract). In the passage relied on by the Examiner, Thomas discloses that the user is provided with an opportunity to select the type of ratings that the user wishes to view and the geographic area for which the ratings should be provided. After the user selected the ratings, they are displayed to the user (¶¶ 70-71). Thomas, however, is unrelated to advertising and discloses selecting types of ratings. That is, Thomas does not disclose or even remotely suggest selecting a category of advertising. Instead, Thomas discloses selecting type of ratings.

Furthermore, the relevance of Thomas is not understood. Stettner already has an indicator 404 for obtaining additional information about a particular merchandise being advertised on the TV. Since the indicator 404 is directly linked to the specific merchandise in Stettner, there is no reason to specify a category. The Examiner alleges that the advantage of the proposed combination is to receive desired advertisements (*see* page 12 of the Office Action). In Stettner, however, the user already receives information directly linked to the desired

merchandise. There is no reason to specify a category when the desired information is already provided with a click of a button. In short, but to somehow meet the unique features of claim 2, one of ordinary skill in the art would not have and could not have combined Thomas with Stettner.

For at least these additional exemplary reasons, claim 2 is patentable over Stettner in view of Thomas.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. **If any points remain in issue, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.**

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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